



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------|------------------|
| 09/672,148 | 09/28/2000 | Daniel F. Daly | P-9766-US1 | 7385 |
| 49443 7590 01/21/2009 Pearl Cohen Zedek Latzer, LLP 1500 Broadway 12th Floor New York, NY 10036 | | | | |
| EXAMINER ARMSTRONG, ANGELA A | | | | |
| ART UNIT 2626 | | PAPER NUMBER | | |
| MAIL DATE 01/21/2009 | | DELIVERY MODE PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/672,148

Applicant(s)

DALY ET AL.

Examiner

ANGELA A. ARMSTRONG

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No./Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to the response filed October 16, 2008.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,274,738. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claims to instant application a and the US Patent are directed to digital modular voice processing and although the claims of US Patent 5,274,738 do not specifically teach storing the audio data on a DAT, storing audio data on a DAT was an obvious modification requiring routine skill in the art.

| | |
|----------------------------|-----------------------------------|
| Claim 1 of the application | Claims of US Patent No. 5,274,738 |
|----------------------------|-----------------------------------|

| | |
|---|--|
| A modular digital recording logger comprising: | A digital modular voice processing system comprising: |
| A housing; | (Claim 7) The system of claim 1 including a housing, said host computer, said first bus, said at least one voice processing card, said second bus, and said at least one audio card being supported by said housing and said at least one voice processing card and said at least one audio card are physically and electrically connected, and said host computer is logically connected to said voice processing card and to said at least one audio card. |
| at least two audio circuits in said housing for converting analog voice signals to digital voice signals, each of said audio circuits including at least two terminals for receiving said analog voice signals, each of said terminals being capable of receiving said analog voice signals for recording a two-way conversation; | an interface for receiving analogue voice signals from a telephone line and converting said analogue voice signals to digital voice data, |
| a circuit in said housing for compressing said digital voice signals received from each of said audio circuits to provide compressed voice | (Claim 5) The system of claim 4 wherein said signal processor has means for performing voice compression and expansion, automatic |

| | |
|---|---|
| data; | gain control, dual tone multi-frequency extraction and voice activated operations |
| a first bus in said housing for providing communication between said audio circuits and said compressing circuit, said first bus enabling the addition or removal of circuits; | (Claim 7) The system of claim 1 including a housing, said host computer, said first bus, said at least one voice processing card, said second bus, and said at least one audio card being supported by said housing and said at least one voice processing card and said at least one audio card are physically and electrically connected, and said host computer is logically connected to said voice processing card and to said at least one audio card. |
| a multiplexer circuit in said housing for providing communication between said compressing circuit and said first bus, wherein said multiplexer circuit multiplexes voice signals exchanged between said compressing circuit and said audio circuits on said first bus; | <p>c) a voice processing card having at least one digital signal processor and at least one application processor in communication with said at least one digital signal processor, a first interface providing communication between said at least one application processor and said first bus, and a first time division multiplexer chip in communication with said at least one digital signal processor,</p> <p>d) a second bus in communication with said first time division multiplexer chip, and</p> <p>e) at least one audio card including a second time division multiplexer chip that communicates with said second bus, an audio processor in communication with said second time division multiplexer chip, and a second interface in communication with said audio processor, said second interface having a</p> |

| | |
|--|---|
| | plurality of ports that provide communication with communication lines. |
| a host computer for controlling the logger; and | a) a host computer having a host processor, and a storage medium, a memory and a bus interface in communication with said host processor, |
| a digital audio tape (DAT) drive for storing said compressed voice data. | (Claim 3) The system of claim 2 wherein said storage medium is a storage disk. |

Response to Arguments

3. Applicant's arguments with respect to claims 1-57 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANGELA A. ARMSTRONG whose telephone number is (571)272-7598. The examiner can normally be reached on Monday-Thursday 11:30-8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick N. Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Angela A Armstrong/
Primary Examiner, Art Unit 2626